

REMARKS

After entry of the foregoing amendments, claims 1-58 are pending in this application. Claims 29-56 are withdrawn from consideration. Claims 1-28 are rejected. New claims 57 and 58 are added via this Amendment.

INTERVIEW:

Applicants thank the Examiner for the courtesies extended during the interview of July 7, 2004, between the Applicants' undersigned representative and Examiner Nguyen. In order to satisfy 37 C.F.R. §1.133, Applicants note that a purpose of the interview was to discuss the applied references, and the failure of the references to disclose the claimed invention including the recited telephony platform, as argued by Applicants' representative. The Examiner noted that the present invention falls within a "sensitive" area of technology and is scrutinized more closely than other art areas. Applicants' representative pointed out that the present invention is to be given the same statutory analysis as any other invention presented to the USPTO. It is submitted to be unconstitutional if any standard of analysis is applied to the present invention that is stricter than what is statutorily required.

35 U.S.C. §102:

Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by Foladare et al. (U.S. Patent No. 6,343,115 [hereinafter "Foladare"]). This rejection is respectfully traversed in view of the following remarks.

It is important to note that the invention of Foladare is in a field distinct from the present invention, although some similar terms are used in both. It is believed that the use of such similar terms has misled the Examiner. Nevertheless, Foladare does not disclose a telephony platform as in the present invention.

As will be appreciated by one skilled in the art, the invention of Foladare involves “call completion” (for example, see claim 1 of Foladare). In other words, Foladare suggests an “improvement” to an already known method of conducting a telephone call over the Internet (or an IP network). This improvement helps two parties to coordinate a conversation by allowing the caller to alert a called party when the caller wishes to initiate a call. This is done by sending a “page” to the called party’s pager (an instrument that is not connected to the Internet). Once the called party receives the “page,” he logs into the Internet (see col. 3, lines 46-55), sometimes using the computer and modem that the Examiner appears to be mistakenly interpreting as a “telephony platform.” The first and second users are then able to speak to each other through their respective personal computers.

Applicants submit that rejections under 35 U.S.C. §102 are proper only when each element of the claimed subject matter is disclosed in the cited reference. Foladare fails to disclose each element presently claimed. Claim 1 is directed to a novel combination of elements that form a new and unobvious apparatus for storing predetermined multimedia information. For example, and not by limitation, Foladare does not disclose a telephony platform and a first

storage location coupled to the telephony platform. Further, Foladare does not disclose a first storage location that stores at least a part of predetermined multimedia information.

A telephony platform, as would have been understood by one skilled in the art at the time of the invention, is not disclosed by a “piece of hardware” that is employed to allow for call completion, as in the conversation of Foladare that is carried out using the Internet. In particular, a telephony platform includes a certain architectural design for a particular application, as would be understood by one skilled in the art. Foladare does not disclose such a feature through its use of a standard personal computer having a modem.

Further, Foladare fails to describe any of its elements as being a “telephony platform.” Although Foladare does use the word “telephony,” it is merely when describing an “Internet telephony call,” and has nothing to do with a platform or hardware. Foladare also uses the word “platform” while describing an “Internet savvy platform;” however, this would have been understood as merely an Internet platform and not a telephony platform.

Moreover, the personal computer having a modem in Foladare is described as accessing the Internet and has nothing to do with providing telephony services. Thus, one would have been taught that the computer and modem of Foladare is merely an Internet access device and not a telephony platform. At best, such a personal computer may correspond to a user communication device, but certainly not a telephony platform as in the present invention.

The Examiner states that Foladare discloses that the “storage location stores multimedia information.” Applicants point out that the only “storage” operation in Foladare is related to storing (in the database 132) information relating to a user such as an Internet address of a service provider.

Consequently, claim 1 cannot be anticipated by Foladare and the rejection of claim 1 under 35 U.S.C. §102(e) should be withdrawn.

35 U.S.C. §103:

Claim 2 is rejected under 35 U.S.C. §103(a) as being anticipated by Foladare. This rejection is respectfully traversed in view of the following remarks.

As an initial matter, Applicants submit that Foladare fails to disclose a telephony platform, as noted above. Further, it is respectfully submitted that one skilled in the art would not have been taught or suggested a telephony platform, as in the present invention, in view of the teachings or suggestions of Foladare. Thus, claim 2 is patentable over Foladare at least by virtue of its dependency on claim 1.

Further, Applicants submit that claim 2 contains individual features that would not have been taught or suggested by Foladare. The lack of Foladare to disclose such features is acknowledged by the Examiner on page 4 in line 6 of the Office Action. Upon acknowledging the failure of Foladare to disclose the claimed features, the Examiner attempts to effectively render meaningless the claimed features by alleging that they should not be given patentable

weight. For example, the features of claim 2 further define, *inter alia*, the first telephony platform, along with the first and second storage locations.

Applicants note that a functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). (See MPEP §2173.05(g).) There is nothing inherently wrong with defining some part of an invention in functional terms. (*Id.*) Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210 (CCPA 1971).

Moreover, a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. (See MPEP §2173.05(g).) A functional limitation is often used in association with an element, ingredient or step of a process to define a particular capability or purpose that is served by the recited elements, ingredient or step. (*Id.*)

Applicants respectfully submit that each feature recited in claim 2 must be given weight and cannot be ignored merely in an effort to support a rejection. Foladare would not have taught the claimed first telephony platform that receives at least one multimedia command from an access device of a user. Further, Foladare would not have taught or suggested that the recited first storage location and the second storage location store at least a part of the predetermined multimedia information, in addition to the other features recited in claim 2. If the Examiner wishes to maintain the rejections, he is requested to particularly point out where such a teaching

or suggestion to provide the features of claim 2 are found in Foladare. Because such a teaching or suggestion presumably cannot be found, the rejection of claim 2 under 35 U.S.C. §103(a) must be withdrawn.

Claim 3

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare. Applicants respectfully traverse this rejection in view of the following remarks.

The Examiner acknowledges that Foladare fails to disclose the use of multimedia information that comprises music information. The Examiner then makes the bare assertion that it would have been obvious to recognize that music information comprises audio signals that could be handled by the system of Foladare.

The Examiner has not provided the requisite motivation to establish why one would have used multimedia information in Foladare that comprises music information, as recited in claim 3. There is no motivation found in the grounds of rejection for claim 3, and the ability of Foladare's system to have "capabilities" of handling multimedia signals would not have motivated one to provide the recited multimedia information comprising music information. It is well established that although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." (Emphasis added.) *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990); (MPEP §2143.01). The Examiner has

not set forth any reason why one would have modified Foladare to include the features of claim 3 in regard to the multimedia information that comprises music information.

Accordingly, Applicants respectfully submit that claim 3 is patentable over Foladare and the rejection thereof under 35 U.S.C. §103(a) should be withdrawn.

Claim 4

Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Barbara et al. (U.S. Patent No. 5,926,789). Applicants respectfully traverse this rejection in view of the following remarks.

The Examiner acknowledges that Foladare fails to disclose the claimed features regarding a music track. The Examiner then turns to Barbara for allegedly teaching that an “audio track” is a musical track. However, the Examiner has not set forth any motivation regarding why one would have combined any teachings of Barbara with Foladare. The Examiner has only indicated that Foladare’s system is “capable to handle these information.” (sic.) (See Office Action, last line on page 5.) As noted above, the ability of a device to be modified is not sufficient to support a *prima facie* case of obviousness under 35 U.S.C. §103 unless there is the requisite motivation to do so.

There is no motivation to provide any sort of music track to the device of Foladare in light of the teachings of Barbara that merely discuss an “audio track.” Furthermore, claim 4 describes that the first multimedia portion contains a first music track of the first music track

group and the second multimedia portion contains a second music track of the first music track group. The Examiner does not even address these features, which further supports the failure of the applied references to teach or suggest the features of claim 4. Therefore, withdrawal of the rejection of claim 4 is respectfully requested.

Claim 5

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Barbara and further in view of Aktas et al. (U.S. Patent No. 6,459,776 [hereinafter "Aktas"]). This rejection is respectfully traversed in view of the following remarks.

The Examiner acknowledges that Foladare fails to disclose the use of a first mailbox and a second mailbox, along with a navigation menu. The Examiner then turns to the secondary references of Aktas and Barbara for allegedly teaching these features. The proposed motivation for combining features of Aktas and Barbara with Foladare is to provide "flexible selections and a capability of navigating a menu to a user." (See Office Action at page 6, lines 11-14.) However, the Examiner is respectfully requested to point out why one would have been motivated to provide such features in Foladare. As noted above, Foladare is directed to allowing two users to speak to each other through personal computers. There is no disclosed need for any sort of navigation menu or different mailboxes discussed in Foladare. Thus, Applicants again note that the ability of a reference to be modified is insufficient to support a rejection under 35 U.S.C. §103 unless there would have been motivation to do so. There is no need discussed in

Foladare for having “flexible selections” and a “capability of navigating a menu.” Accordingly, withdrawal of the rejection of claim 5 is respectfully requested.

Claims 6 and 7

Claims 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Barbara and further in view of Aktas. The rejection is respectfully traversed in view of the following remarks.

The Examiner acknowledges that Foladare, Barbara and Aktas fail to disclose menu navigational inputs that comprise a group of an artist, album name or a type of music. The Examiner attempts to assert that these features are “non-functional of the descriptive material and are not functionally involved in the apparatus recited.” (See Office Action at page 7, line 1.) The Examiner’s position is not understood. The features of claim 6 further define aspects of the invention, including a required input having particular details. Such a description further defines the physical aspects of the claims by requiring a device that is capable of receiving such inputs. These features cannot be ignored. As is well established, all features of a claim must be taught or suggested. (See MPEP §2143.)

The Examiner also alleges that it would have been obvious to “input any type of data or any type of content.” The Examiner’s position is not understood because it would not have been obvious to input information regarding a group, artist name or a first music track, etc., as found in claim 6, into a device of Foladare that teaches to allow for two users to communicate through

the Internet. Thus, claim 6 is submitted to be patentable over the applied references, and the rejection thereof should be withdrawn.

The Examiner has not pointed to where the features of claim 7 are found in the applied art. The features of claim 7 further define the first music track and the second music track as corresponding to music tracks on an album. The Examiner's reasoning is also not understood because he asserts that the music tracks contain "non-functional descriptive material for an apparatus claim." This position appears to be contrary to the Examiner's previous position where he tried to assert that functional language should be ignored. The Examiner is respectfully requested to reassess his position in light of the proper standards used for presenting rejections under 35 U.S.C. §103. Claim 7 is accordingly deemed to be patentable over the applied references, and the rejection thereof should be withdrawn.

Claims 9 and 12

Claims 9 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Barbara and further in view of Aktas. This rejection is respectfully traversed in light of the following remarks.

The Examiner acknowledges that Foladare does not disclose any features regarding a purchase command to have a copy of an album mailed to a personal address of a user. The Examiner then alleges that this feature is "an intended use of the claimed apparatus."

As an initial matter, Applicants point out that the standard applied by the Examiner is used when evaluating a preamble, and not features found in the body of a claim. In particular, “if a particular structure is capable of performing the intended use as recited in the preamble, then it meets the claim.” (Emphasis added.) See, e.g., *In re Schreiber*, 128 F.3d 1437, 1477 (Fed. Cir. 1997); (MPEP §2111.02). The feature noted by the Examiner is not found in the preamble. Instead, the feature further defines the claims by requiring the apparatus to be configured such that it can recognize and act on the recited purchasing command. This feature is neither taught nor suggested by the prior art, as evidenced by the Examiner’s inability to point to where in the references this feature is disclosed. Furthermore, the Examiner has not provided any motivation, as required, indicating why one would have modified the references to include such a feature. The Examiner only states that the claimed features are “a specific application of a user.” (See Office Action at page 9, line 2.) However, just because a claimed feature is a specific application does not equate to the prior art making the feature obvious when such a feature is not even mentioned in the prior art. This is clearly not the proper standard for judging obviousness. Therefore, withdrawal of the rejection is respectfully requested.

Claims 10 and 13

Claims 10 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Barbara and further in view of Aktas. Applicants respectfully traverse this rejection in view of the following remarks.

The Examiner acknowledges the failure of the references to disclose the features of claims 10 and 13. Thus, the Examiner again improperly relies on an assertion of “intended use.” However, as noted above, the Examiner cannot merely ignore the claimed features found in the body of a claim by asserting that they are intended use. Moreover, the Examiner has not provided any grounds of reasoning as to why one would have been motivated to modify the applied references to include the features of claims 10 and 13 regarding the purchasing command or the inherent requirement that the first telephony platform be structured to provide the aspects of claims 10 and 13. Thus, withdrawal of the rejection of claims 10 and 13 under 35 U.S.C. §103(a) is respectfully requested.

Claim 14

Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Barbara. Applicants respectfully traverse this rejection in view of the following remarks.

Claim 14 further defines the first music track and the user memory portion. The Examiner clearly has not found either of these features (as described in claim 14) in the applied references and must again rely on an assertion that the claimed features are “non-functional descriptive material.” As noted above, such an assertion is without merit because the features of claim 14 further define the invention and are required to be considered. Thus, withdrawal of the rejection of claim 14 is respectfully requested.

Claim 15

Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Barbara and in view of Kelkar et al. (U.S. Patent No. 6,182,128 [hereinafter “Kelkar”]). This rejection is respectfully traversed in view of the following remarks.

The Examiner acknowledges that Foladare and Barbara fail to disclose the first data that is music data of the first music track. Kelkar is cited for disclosing music data that is indexed. It is respectfully submitted that there is no motivation to combine the features of Kelkar along with Barbara and Foladare because of at least the lack of teaching or suggestion (or even need) to modify Foladare to include any sort of information regarding music data of a first music track. As noted above, the ability of a reference to be “capable” of being modified is insufficient to support a rejection under 35 U.S.C. §103(a), unless there is motivation provided by the art to do so. No motivation is found in the applied references. Therefore, withdrawal of the rejection of claim 15 is respectfully requested.

Claim 16

Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Barbara and in view of Kelkar. This rejection is respectfully traversed in view of the following remarks.

The Examiner acknowledges that Foladare and Barbara fail to disclose that the recited first data is music data of a first track. The Examiner also apparently acknowledges that Kelkar

fails to disclose these elements because he does not indicate how Kelkar would have taught or suggested the claimed features.

Claim 16 defines that the first data is pointer data that identifies the first storage location containing the first music track. As would be appreciated by one skilled in the art, these features further define the first data that is a physical aspect of the invention. The Examiner makes various “boiler plate” assertions in regard to claim 16, but has ultimately failed to show how the references would have taught or suggested these features. It is clear that the Examiner cannot ignore such features. Any attempt to do so further supports Applicants’ position that the references would have failed to teach or suggest the claimed features. Accordingly, withdrawal of the rejection of claim 16 is respectfully requested.

Claim 17

Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Barbara and in view of Kelkar. This rejection is respectfully traversed in light of the following remarks.

The Examiner relies on Kelkar for allegedly disclosing music data that is indexed by music tracks. The Examiner then makes a broad assertion that it would have been obvious to combine such a teaching with Foladare because “the order of input data are maintained with the order of tracks for easy recognition.” (See Office Action at page 13, second full paragraph.) However, the Examiner is again requested to point out why anyone would have modified the

system of Foladare to have the claimed features regarding music tracks in light of Foladare clearly teaching a system wherein two users speak to each other through the Internet using personal computers. In effect, there is no motivation to combine the references to provide the features of claim 17, thus requiring withdrawal of the rejection thereof under 35 U.S.C. §103.

Claims 8, 11, 18 and 19

The Examiner does not specifically set forth a rejection of claims 8, 11, 18 and 19, but instead refers to the rejection of claim 7, which is traversed. Applicants respectfully submit that claims 8, 11, 18 and 19 are patentable over the applied references for the same reasons set forth above in regard to claim 7. In particular, the Examiner cannot merely ignore claimed features because the references fail to teach such features. As would be understood by one skilled in the art, the elements of claims 8, 11, 18 and 19 require the claimed apparatus to have particular features to carry out aspects of these claims. The Examiner's lack of application of any reference against the individual features of these claims further supports their novel and unobvious features. Accordingly, claims 8, 11, 18 and 19 are respectfully submitted to be patentable over the applied references, thus requiring withdrawal of the rejection.

Claim 20

Claim 20 is rejected under 35 U.S.C. §103 as being unpatentable over Foladare in view of Barbara and in view of Kelkar. The rejection is respectfully traversed in view of the following remarks.

The Examiner alleges that one would have been motivated to apply the teachings of Kelkar to Barbara and Foladare so as to “suggest that additional music data are saved to additional music tracks because the order of input data are maintained with the order of tracks for easy recognition.” (See Office Action at page 15, last paragraph.) It is respectfully submitted that the Examiner’s alleged motivation is improper because a suggestion in one reference that additional music tracks are saved in a particular order would not have motivated one to modify Foladare to have such a feature. The Examiner is respectfully requested to explain why one would apply this aspect to the system of Foladare. The Examiner is also respectfully requested to point out how such a feature of Kelkar would aid the invention of Foladare.

Furthermore, claim 20 describes that the first telephony platform sequentially outputs the saved tracks to the access device in response to the radio playback command. The Examiner has not even addressed these features or shown where they are presented in the prior art. Accordingly, it is clear that the references fail to disclose this feature, thus requiring withdrawal of the rejection.

Claim 21

Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Stokes (U.S. Patent No. 4, 870,515). This rejection is traversed.

The Examiner acknowledges that Foladare fails to disclose a multimedia command comprising a forwarding command. The Examiner then turns to Stokes and alleges that it teaches to

forward through various music tracks. However, the bare disclosure in Stokes of forwarding through music tracks would not have taught the features of claim 21 regarding the first telephony platform that forwards the selected multimedia portion to a second access device of a user in response to the forwarding command. The “fast forward” aspect of Stokes is different than the forwarding command of claim 21, as should be understood upon a reading of the claim. The Examiner has not addressed these features in the manner that they are used in the claim, nor has the Examiner shown where such features are taught or suggested by the applied art. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 22 and 24

Claims 22 and 24 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Foladare in view of Stokes. This rejection is respectfully traversed in light of the following remarks.

The Examiner alleges that Foladare “obviously” teaches the features of claim 21. However, the Examiner is not able to point to any portion of Foladare that allegedly teaches such features. The aspects of claims 22 and 24 are to be given patentable weight because they further define aspects of the invention - aspects which are neither taught nor suggested by the applied art.

Further there is no motivation in Foladare to provide the claimed distribution list that has been created by the user and stored in the at least first telephony platform prior to inputting the

recited forwarding command. The only argument that the Examiner is able to set forth regarding a motivation is that the claimed features are aspects that “Foladare[’s] and Stokes’ system would be able to perform.” (See Office Action at page 17, line 18.) However, as noted earlier, it is well settled that “although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990); (MPEP §2143.01). Further, there is no disclosed reason that would have motivated one to incorporate any features of the recording device of Stokes into the system of Foladare, nor is it clear how such a combination would even be accomplished. It is thus submitted that claims 22 and 24 are patentable over the applied references, requiring the rejection thereof under 35 U.S.C. §103(a) to be withdrawn.

Claim 23

Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare in view of Stokes. This rejection is respectfully traversed in view of the following remarks.

The Examiner improperly attempts to submit that the features of claim 23 would have been obvious because the language of claim 23 “should be distinguished from cited prior art in terms of structure rather than function.” (See Office Action at page 18, lines 7-8.) First, the Examiner alleges that the claimed features would have been obvious without giving a reason -

which is improper.¹ Second, as noted above, functional language is to be given weight and the mere fact that a reference is “capable” of performing a function is not sufficient to support an obviousness rejection unless there is motivation to modify the reference to produce the claimed features. In this case, there is no motivation to modify Foladare with Stokes to obtain the claimed invention.

Moreover, the relied upon forwarding aspect of Stokes is used merely for forwarding between tracks of a music file. However, as one skilled in the art would understand, the forwarding feature found in the claims does not merely include forwarding between tracks, but instead refers to the first telephony platform that forwards a selected multimedia portion to a storage location corresponding to a second access device of a second user. This feature is not found in Stokes. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 25-28

Claims 25-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Foladare. This rejection is respectfully traversed in light of the following remarks.

In regard to claims 25-28, the Examiner makes the bare assertion that Foladare is capable of providing the features found in the claims. (See Office Action at page 19, line 1.) However, as noted above, Foladare fails to disclose the claimed telephony platform and thus claims 25-28

¹ The assertion that claim 23 recites a function is clearly not grounds to assert a claimed feature is obvious.

are patentable over Foladare for at least this reason. Further, the mere ability or capability of an apparatus to provide a feature is not sufficient to support the rejection unless there would have been motivation to modify the references to have the feature. It is clear that the features of claims 25-28 are not taught or suggested by Foladare, requiring the rejection of claims 25-28 to be withdrawn.

CONCLUSION:

As noted in multiple instances above, the Examiner cannot merely ignore claimed features in an effort to support a rejection. All aspects of the claims are to be considered when judging patentability. The Examiner is respectfully requested to reconsider all of the rejections using the proper standard as required by 35 U.S.C. §§102 and 103.

NEW CLAIMS:

Applicants add new claims 57 and 58 to obtain more varied protection for the invention. These claims are submitted to be patentable over the applied references at least by virtue of their dependency on claim 1.

In view of the preceding amendments and remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby earnestly solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is kindly requested to contact the undersigned attorney at the local telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Serial No. 09/648,532

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The USPTO is directed and authorized to charge all additional required fees (except the Issue/Publication Fees) to our Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

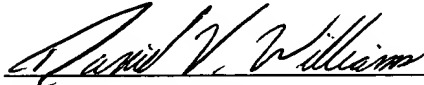
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